



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,900	11/02/2001	Harry E. Gruber	00010.US00	8511

7590 03/02/2005

MICHAEL A RAHMAN
DORSEY & WHITNEY LLP
1420 FIFTH AVENUE SUITE 3400
SEATTLE, WA 98101

EXAMINER

NGUYEN, TAN D

ART UNIT	PAPER NUMBER
----------	--------------

3629

DATE MAILED: 03/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/004,900

Applicant(s)

GRUBER ET AL.

Examiner

Tan Dean D. Nguyen

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/31/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 1/31/05 was filed after the mailing date of the application on 11/02/2001. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

2. Claims 21-26, 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 21, it's not clear the relationship of the "(A) playing a game ..." to the preamble or to the next step "(C) making a donation ...". Who is playing the game and why making a donation and due to what incentive?

Claim 22 recites the limitation "the player" in line 2. There is insufficient antecedent basis for this limitation in the claim. Also, claim 22 is vague and indefinite because it depends on itself.

Claim 25 recites the limitation "the contact information" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 27 recites the limitation "the player" at the last line. There is insufficient antecedent basis for this limitation in the claim.

Claim Objections

3. Claims 24, 26 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It's not clear how these claims further limit the scope of claim 21 since no further explanation are present.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in ***Graham vs. John Deere Co.***, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 21-26, 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over COSTIN, IV et al in view of InterLotto.

As for independent method¹ claim 21, COSTIN, IV et al fairly teaches a web-based {see Fig. 1, 2}, interactive {see [0006] method for simultaneously:

Art Unit: 3629

(a) advertising and increase awareness {see [0020-0021]} of charitable, nonprofit, philanthropic or other fundraising organizations (ORG) {see Fig. 2, (42), (44), Fig. 17 and [0066]},

(b) advertising corporate or other sponsors {see Fig. 1 (12), [0063, 66 "sponsors"]},

(c) raising donations for the ORGs, {see Fig. 2}, the method having a graphical user interface including a display or computer screen {see Fig. 1a (20)}, comprising:

(A) interaction between the consumer and the Business/Sponsor by involving the consumer/participant in a related business transaction in a cause marketing by a Business acting as a Sponsor for a fundraising campaign on a website {see Fig. 1b, 2, 0006, 0063};

(B) making a donation, by the Sponsor, to an ORG {see [0063 "source of funding are corporate sponsor"], Fig. 1a (12, 14), or Fig. 1b "(12) Business/Sponsor"}. Note on [0020], COSTIN, IV et al fairly teaches the use of Internet marketing (including advertising) and recommendation of friend to increase brand (reading over product or service or business or company or organization) awareness, increasing traffic and acquiring customers. Alternatively, it would have been obvious to modify brand awareness to include business or company or organization.

COSTIN, IV et al fairly teaches the invention except for step (a) wherein the interaction is playing a game.

In another fundraising campaign for cause marketing process, InterLotto fairly teaches (a) a player playing game on a website in responding to a cause marketing proposal by a Business/Sponsor (InterLotto) and (b) the Business/Sponsor making a

Art Unit: 3629

donation to a charity ORG when a player is playing the game and win the prize {see abstract}. It would have been obvious to modify the process of COSTIN, IV et al by using game playing as part of participant's involvement in the business transaction as taught by InterLotto as part or fundraising step for donation to charity while meeting participant's need or hobby (playing a game) vs. buying a personal item as in COSTIN, IV et al.

As for dep. claims 22, 23 (part of 21), which deals with well known gaming practice parameters, i.e. winning points, type of game, i.e. sweepstake or lottery, these non-essential to the scope of the claimed invention and are fairly taught in InterLotto article.

As for dep. claims 24, 25 (part of 21), which deals with well known fundraising campaign parameters, i.e. contacting participant using email, these are non-essential to the scope of the claimed invention and are fairly taught in COSTIN, IV et al [0010, 0071].

As for dep. claim 26 (part of 21), which deals with well known fundraising campaign parameters, i.e. totalizing participants, this is non-essential to the scope of the claimed invention and is fairly taught in COSTIN, IV et al [0021 "Total results"].

As for Independent Product claim 27, which is the computer program product to carryout the method claim 21 above, it's rejected over the computer program product of COSTIN, IV et al in view of InterLotto to carry out the method claim 21 as rejected above.

7. Claims 1-11 (method²) , 12-20 (apparatus²) are rejected under 35 U.S.C. 103(a) as being unpatentable over COSTIN, IV et al in view of InterLotto and SHAHAR.

As for independent method² claim 1, the teachings of COSTIN, IV et al in view of InterLotto is cited above. In another Internet marketing method, SHAHAR fairly teaches a method that enables vendor or business entity to use established marketing channels to involve consumers in interactive games on the Internet which allows business entity to obtain user profile information easily which is valuable information for potential business transaction {see [0016-0017]}. SHAHAR also teaches various types or embodiments of games or wherein game include quiz or test or questions and answers type {see [0071, 0029 or 0081]}. It would have been to modify the teachings of COSTIN, IV et al / InterLotto by playing other type of game, such as quiz by answering listed questions, as taught by SHAHAR above as mere using other well known type of game for obtaining valuable user profile information as indicated above.

As for dep. claims 2-3 (part of 1), which deals with gaming/quiz questioning parameter, i.e. information with respect to the ORG's or Sponsor mission and activity, SHAHAR fairly teaches the asking of the question to obtain information about the player {see 0081-0083} and many obvious alternatives and modifications {see [85]}, therefore, the asking of the question to obtain information about any other parties involved would have been obvious if desired as taught by SHAHAR above.

As for dep. claims 4-5 (part of 1), which deals with well known fundraising campaign parameters, i.e. contacting participant using email, these are non-essential to

the scope of the claimed invention and are fairly taught in COSTIN, IV et al [0010, 0071].

As for dep. claims 6-7 (part of 1), which deals with well known gaming parameters, i.e. totalizing winning scores participants, this is non-essential to the scope of the claimed invention and is fairly taught in InterLotto and SHAHAR [0072, 0081, 0083].

As for dep. claims 8-9 (part of 1), which deals with well known marketing parameters, i.e. providing contact information to Sponsor or Org, these are fairly taught in COSTIN, IV et al [0071-0073] or SHAHAR [0016, 0047, or 0075].

As for dep. claim 10 (part of 1), which deals with well known fundraising campaign parameters, i.e. selecting an ORG by participant, this is non-essential to the scope of the claimed invention and are fairly taught in COSTIN, IV et al [0063] or InterLotto (abstract "players select").

As for dep. claim 11 (part of 1), which deals with well known gaming parameters, i.e. an additional sweepstake game, this is non-essential to the scope of the claimed invention and is fairly taught in InterLotto (abstract "many onlie games ... Lotto game, .. chance to win a jackpot prize) or SHAHAR [0029 or 0071]. Moreover, mere duplicate of games for multiple effects is well known practice and would have been obvious to a skilled artisan, absent evidence of unexpected results. See *In re Harza*, 124 USPQ 378, 380; 274 F. 2d 669 (CCPA 1960).

As for Independent System claim 12, which is the web-based interactive system to carry out the web-based interactive method claim 1 above, it's rejected for the

Art Unit: 3629

same reasons set forth in claim 1 above (merely changing from "step for" to "means for").

As for dep. claims 13-20 (part of 12), which have the same limitations as in dep. claims 2-11 (part of 1) above, they are rejected for the same reasons set forth in dep. claims 2-11 above.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(1) NPL: Article "Beware of Charity Season Scams" is cited to teach various fundraising techniques by charities, especially why charities seldom hold sweepstakes.

(2) US: US 2002/0111815 is cited to teach system and method for enabling users of gaming activities to make contributions to charities.

No claims are allowed.

Art Unit: 3629


9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053 or (571) 272-6806 (by April 15, 2005). My work schedule is normally Monday through Friday from 7:00 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 872-9306. My personal Fax is (703) 872-9674. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
February 28, 2005


DEAN T. NGUYEN
PRIMARY EXAMINER